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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/874,057	06/06/2001	Takehiro Nishiyama	209396US-2X	5638

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,057

Applicant(s)

NISHIYAMA, TAKEHIRO

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/30/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicant's response of 9/30/04 has been entered. A copy of a signed 1449 is included with this office action. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 1,13,14,15,16, the language defining a class of specification that is easy to change and not easy to change is considered indefinite. The examiner understands that this refers to various types of equipment on a vehicle that are capable of being changed (i.e. buckets, arms, etc.). It is not known what constitutes *easy* to change and what constitutes *not easy* to change so one wishing to avoid infringement would not be able to determine the scope of this claim. The examiner takes the position that whether or not something is easy to change depends on the individual who is doing the changing and this conclusion is not a definite thing but is more of an opinion of one person versus another person. One person may feel that a slope finishing bucket is easier to change than a normal bucket whereas another person may feel the opposite. The claim is also indefinite for another reason relating to this language. The claim as newly amended states that the server performs a search using the specification information that is easy to change and is not easy to change as essential and equivocal

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search items; however it has not been recited that the person seeking the rental inputs anything more than the type of machine desired to be rented, the time of rental, and place of rental. How can the server search using information (search items) that the person has not entered? It is not clear whether or not the scope of this claim requires the person seeking the rental to specify data regarding the easy to change and not easy to change specification type, or if the claim only requires the inputting of the information stated in lines 8-11 of the claim. The essential search item and equivocal search item can only be searched if the person seeking the rental inputs them as search criteria, but nothing like this has been claimed. The scope of this claims is not clear and is considered indefinite.

For claim 4, how can the server search for a wider area and narrower area if the person seeking the rental has not input any of this information as search items? It is not clear whether or not the scope of this claim requires the person seeking the rental to specify data regarding the wider and narrower geographical areas, or if the claim only requires the inputting of the information stated in lines 8-11 of claim 1.

Correction is required.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

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only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al. (6134534).

Walker discloses a system that allows a customer to purchase or secure a reservation online. Applicant should take notice that with respect to the limitations stating that the system is for renting a construction machine and searches associated construction machine search data, this is considered to be non-functional descriptive material and is given minimal patentable weight. *In re Gulack*, 217 USPQ 401 (CAFC 1983). The type of data being stored does not render the system patentable. The renting of construction machines is the intended use of the system and in article claims it is the recited structure that is given patentable weight, not the intended use of the device.

Walker discloses a system that has a network server 200 that holds service provider type of information as claimed (holds data relating to rentals). There is also disclosed a network terminal 110 that is capable of taking inputted data as claimed. The server searches with the inputted search criteria for information on services, etc.. that satisfy the search criteria. Walker discloses a system as claimed that is fully capable of operating as claimed. Walker discloses structurally what has been claimed.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6,8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Newswire article (2/3/00) in view of www2.hertz.com, Hertz Interactive Reservations Process, The Hertz Corporation, 8pp., 1999.

For claims 1-4,6,8,9,10,13, the newswire article discloses a company that handles online rentals of construction machinery. A database (network server) storing the type of equipment for rent is maintained and also contains availability information. That availability information inherently includes the current or projected use of the equipment. Newswire also discloses that online rental requests are processed. The newswire article does not disclose having the customer input search criteria, having the server search for information on machines that satisfy the search criteria, and providing the customer with the results. Hertz discloses an interactive process for the online reservation and rental of vehicles. The interactive process allows a customer to input a desired location for the rental to take place, input the desired type of vehicle to rent, specify date of rental period, and then a search is performed and results are displayed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the online rental procedure disclosed in the Newswire article with a search function as disclosed by Hertz, so that a customer can do an equipment search based on location, type of vehicle, and rental period.

Applicant should take notice that the recitation of the type of data that the network server is holding (specification information that is easy to change and not easy to change or wider area and narrower area) is taken as non-functional descriptive

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material that does not serve to distinguish over the prior art because there is no positive recitation that the data being manipulate or used in any manner. Applicant is defining the type of data that the server stores and this is the extent to which this language has been considered. The examiner also takes notice that claim 13 only states that the server is "allowed to hold at least information related to....". This is just reciting that the server has the ability to hold this information, which is completely different than actually holding the information.

For claim 5, not disclosed is that the machine to be rented is a tracklaying construction machine. The newswire article discloses that the type of machinery to be rented includes construction equipment, heavy machinery, etc.. It would have been obvious to one of ordinary skill in the art at the time the invention was made to rent a tracklaying machine as claimed. The newswire article discloses the main concept of renting construction equipment so reciting that the machine is of a specific type will not serve to patentably distinguish over the prior art.

For claim 11, the system of the newswire article will provide the customer with information on dates a machine is available for rent. Not disclosed is that the information is presented in the form of a calendar. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the dates a machine is available for rent in the form of a calendar. A calendar is the customary manner in which people schedule things and is an easy to understand type of format for the customer.

For claim 12, in the event that for some reason a search could not be performed it would have been obvious to one of ordinary skill in the art at the time the invention was made to display some sort of default page that contains information. With respect to reciting that the server provides information relating to a machine owned by a holder of said server network, applicant has not disclosed that this step solves a particular problem or produces an unexpected result, so the examiner considers that the content of the page displayed if the search cannot be executed is considered obvious to one of ordinary skill in the art.

7. Applicant's arguments filed 9/30/04 have been fully considered but they are not persuasive.

With respect to the amended language added to the independent claims, for the reasons set forth in the 112,2nd paragraph rejection, this language is indefinite. It appears that applicant is more or less trying to argue patentability based on the type of data that the server stores. Data is data, and as the claims are currently drafted, reciting the type of data that the server stores is considered to be non-functional descriptive material. Additionally, in the instant claims, applicant has never recited that the person seeking the rental ever inputs anything more than type of machine, time, and place. Applicant is arguing limitations that the steps of the method claim do not require. The server cannot search using information that has never been inputted by the person seeking the rental. For this language to get more patentable weight, the claims should be reciting in a positive manner that the person seeking the rental inputs this information

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(essential items and equivocal items) so that the search is then conducted using this information as search criteria. The claims only require the desired machine type, time, and place, to be inputted, so it is not possible to search for items that are not inputted as search items. The 103 rejection set forth by the examiner results in the vehicle type, time and place being searched for, which is all that the claims currently require.

With respect to the use of the "Hertz" TM reference, this reference was used to show a teaching of having a search function for the renting of an item. Hertz does not have to disclose the rentals of construction equipment or disclose the two types of data (easy to change, not easy to change) as has been argued. Because of the problems with the claims under 112,2nd, it is not even clear if the claims require this type of search step because the person seeking the rental is not recited as inputting this information.

With respect to Walker, applicant has provided no argument for patentability other than stating that Walker does not deal with the renting of construction machines. Claims 14-16 are directed to a system that has a server and a terminal with the intended use being for the renting of construction machines. Claims 14-16 are not method claims and the patentability of these claims comes down to the recited structure, which is disclosed by Walker.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DENNIS RUHL
PRIMARY EXAMINER